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## REMARKS

### I. Response to Rejection Under 35 USC §112

At page 2, item 2 of the Office Action, claims 33-36 are rejected under 35 USC §112, as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as the invention. To overcome the rejection, the Applicants have used the language of Section 2106 (V)(A)(2) of the MPEP to clarify the claimed use of the computer-readable media to perform the steps of the method. Support for this amendment can be found at page 13, lines 14-17 of the specification.

### II. Response to Rejections Under 35 USC §102

At page 2, item 4 of the Office Action, claims 1-3, 5, 27, 37, and 40 are rejected under 35 USC § 102(e) as being anticipated Kahle (US Patent Number 6,074,031, hereinafter referred to as '031). However, '031 does not disclose a system for labeling a storage media that includes "means for arranging images, said *images* corresponding to *images* encoded on said storage media", as recited in independent claim 1. Nor does '031 disclose a storage media having "a second side which stores *images* that correspond to said *images* encoded on said first side", as recited in independent claim 27. Nor does '031 disclose a method of preparing a label for a storage media that includes "arranging images in a memory of a computer, said *images* corresponding to *images* encoded on said storage media", as recited in independent claim 37. (Italics added)

In the Applicants' claims and specification, the word "image" has been chosen to express, "a reproduction or imitation of the form of a person or thing", as defined in Merriam-Webster online dictionary at <http://www.m-w.com/>. In claim 1, the images arranged by the "means for arranging images" are, indeed, reproductions or imitations that correspond to the images encoded on the storage media.

In the Applicants' claims and specification, the terms "image" and "images" have been purposely selected to be differentiated from other, character-based information, such as a "title", as recited in claims 7-9, for example. The Applicants believe that this "title" information, as recited in claims 7-9 and shown figuratively in Figure 5 (460) of the specification corresponds to the "label data" referred to in column 5, line 66, through column 6, line 5 of the '031 disclosure (cited by the Examiner). Thus, the Applicants believe that the '031 disclosure is silent on the aspect of a system for labeling a storage media that includes "means for arranging *images*, said *images* corresponding to *images* encoded on said storage media", as recited in independent claim 1. '031 is also silent on the aspect of a storage media having "a second side which stores *images* that correspond to said *images* encoded on said first side", as recited in independent claim 27. '031 is also silent on a method of preparing a label for a storage media that includes "arranging *images* in a memory of a computer, said *images* corresponding to *images* encoded on said storage media", as recited in independent claim 37.

Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection under 35 USC 102 since the cited reference does not include the limitations recited in the Applicants' claims.

### **III. Response to Rejections Under 35 USC §103**

At page 4, item 2 of the Office Action, claims 4, 6-10, 12-13, 16-19, 22, 26, 28-32, 38, and 41 are rejected under 35 USC §103(a) as being unpatentable over '031 in view of Kahle (US Patent Number 5,818,325, hereinafter referred to as '325). However, neither the '031 nor the '325 reference, taken either individually or in combination therewith, disclose, suggest, or mention a system for labeling a storage media that includes "means for arranging *images*, said *images* corresponding to *images* encoded on said storage media", as recited in independent claim 1. Nor does the combination disclose, suggest, or mention a method of labeling a storage media that includes "arranging *images* in a memory of a computer, said arranged *images* corresponding to *images* encoded on said storage media",

as recited in independent claim 6. Nor does the combination disclose, suggest, or mention a label that affixes to a storage media that includes "a second side, wherein *images* are printed on said second side and wherein said *images* correspond to *images* encoded on said storage media", as recited in independent claim 18. Nor does the combination disclose, suggest, or mention a storage media that includes "a second side which stores *images* that correspond to said *images* encoded on said first side", as recited in independent claim 27. Nor does the combination disclose, suggest, or mention a system for labeling a storage media that includes "a computer for arranging *images* that correspond to *images* encoded on said storage media", as recited in independent claim 31. Nor does the combination disclose, suggest, or mention a method of preparing a label for a storage media that includes arranging *images* in a memory of a computer, said *images* corresponding to *images* encoded on said storage media", as recited in independent claim 37.

Neither the '031 nor the '325 references include any suggestion, mention of printing "images" on a side of the CD, or a label, that would correspond to the images encoded on the other side of the CD. In the '031 reference, "label data" is printed on a side of the CD. This data is not disclosed as being "images", as recited in the Applicant's independent claims. In the '325 reference, the data printed on the CD appears to be text information, as opposed to "images", as recited in the Applicants' independent claims. Thus, since neither reference includes the limitation of printing "images", these references cannot be combined to produce the invention of claims 1, 6, 18, 27, 31, and 37.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in the Applicants' claims.

At page 5, item 3 of the Office Action, claims 11 and 39 are rejected under 35 USC 103(a) as being unpatentable over '031 in view of '325 as applied to claims 6, 10, and 37, and further in view of Felleman (United States patent number 6,097,503, hereinafter referred to as '503). However, neither

'031 nor '325 nor '503, taken either individually or in combination therewith, suggest or mention a method of labeling a storage media that includes "arranging *images* in a memory of a computer, said arranged *images* corresponding to *images* encoded on said storage media", as recited in independent claim 6. Nor do the cited references, taken either individually or in combination therewith, suggest or mention a method of preparing a label for a storage media that includes "arranging *images* in a memory of a computer, said *images* corresponding to *images* encoded on a storage media", as recited in independent claim 37.

Neither the '031 nor the '325 nor the '503 references include any mention of a method of labeling or preparing a label for a storage media that includes arranging "images". As previously mentioned, '031 includes some mention of "label data" being recorded on the compact disc. However, this data is not disclosed as being an "image". In '325, there is no mention of printing "images" on a first side that correspond to images recorded on a second side of a CD. In '503, a bi-level conversion to contone data is disclosed. However, '503 makes no mention of a method of labeling or preparing a label for a storage media that includes arranging images for labeling a storage media wherein "said arranged *images* correspond to *images* encoded on said storage media", as recited in independent claim 6 and 37. When taken in combination, these references do not suggest or mention the Applicants' claims.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in the Applicants' claims.

At page 5, item 4 of the Office Action, claims 20-21 are rejected under 35 USC 103(a) as being unpatentable over '031, in view of '325, and further in view of Tracy (United States patent number 5,770,289, hereinafter referred to as '289). However, none of these references, taken either individually or in combination therewith, suggest or mention a label that affixes to a storage media that includes a second side "wherein *images* are printed on said

second side and wherein said *images* correspond to *images* encoded on said storage media".

Neither '031 nor '325 nor '289 include any mention of a label on which "images" are printed that correspond to images encoded on the storage media. As previously mentioned, '031 includes some mention of "label data" being recorded on the compact disc. However, this data is not disclosed as being an "image". In '289, a die cut self-adhesive label sheet for labeling compact discs is disclosed. However, '289 does not include any mention of printing "images" which might be related to material encoded on the compact disc. When taken in combination, these references do not suggest or mention the Applicants' claims.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in the Applicants' claims.

At page 6, item 5 of the Office Action, claims 14-15 and 23-25 are rejected under 35 USC 103(a) as being unpatentable over '031, in view of '325, and further in view of Levy (United States patent application publication number 2002/0146147, hereinafter referred to as '147). However, none of these references, taken either individually or in combination therewith, suggest or mention a method of labeling a storage media that includes "arranging *images* in a memory of a computer, said arranged *images* corresponding to *images* encoded on said storage media", as recited in independent claim 6. Nor do these references, taken either individually or in combination therewith, suggest or mention a label that affixes to a storage media that includes "a second side, wherein *images* are printed on said second side and wherein said *images* correspond to *images* encoded on said storage media", as recited in independent claim 18.

Neither '031 nor '325 nor '147 include any mention of arranging "images", as in claim 6, nor a label upon which "images" are printed that correspond to images encoded on said storage media. As previously mentioned, '031 includes some mention of "label data" being recorded on the compact disc. However, this data is not disclosed as being an "image". In

'147, a digitally watermarking physical media is disclosed. However '147 does not include any mention of arranging or printing "images" that might be related to material encoded on the compact disc. When taken in combination, these references do not suggest or mention the Applicants' claims.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in the Applicants' claims.

At page 7, item 6 of the Office Action, claims 33-35 are rejected under 35 USC 103(a) as being unpatentable over '031 in view of '325 and Willis (United States patent number 5,040,003, hereinafter referred to as '003). However, none of these references, taken either individually or in combination therewith, suggest or mention a computer readable media encoded with executable instructions that cause a computer to perform a method which includes "arranging *images* in a memory of said computer, said *images* corresponding to *images* encoded on said storage media", as recited in amended independent claim 33.

Neither '031 nor '325 nor '003 include any mention of arranging "images" in the computer-readable media claim of claim 33. As previously mentioned, '031 includes some mention of "label data" being recorded on the compact disc. However this data is not disclosed as being an "image". In '003, a method and apparatus for recording color with plural printheads is disclosed. However' 003 does not include any mention of arranging "images" that might be related to material encoded on a compact disc. When taken in combination, these references do not suggest or mention the limitations present in amended independent claim 33.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in the Applicants' claims.

At page 7, item 7 of the Office Action, claim 34 is rejected under 35 USC 103(a) as being unpatentable over '031 in view of '325 and '003 (Willis) and further in view of '503 (Felleman). However, none of these references,

taken individually or in combination therewith, suggest or mention a computer readable media encoded with executable instructions that cause a computer to perform a method which includes "arranging *images* in a memory of said computer, said *images* corresponding to *images* encoded on said storage media", as recited in amended independent claim 33.

None of the aforementioned references includes any mention of arranging "images" as in the computer-readable media of claim 33. Although '031 includes a mention of "label data" being recorded on the compact disc, this data is not disclosed as being an "image". None of the other references include any mention or suggestion of printing or arranging "images". Thus, when taken in combination, these references do not disclose or suggest the material in amended independent claim 33.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in the Applicants' claims.

At page 8, item 8 of the Office Action, claim 36 is rejected under 35 USC 103(a) as being unpatentable over '031, in view of '325 in view of '003 (Willis) and further in view of '147 (Levy). However none of these references, taken either individually or in combination therewith, suggest or mention a computer readable media encoded with executable instructions that cause a computer to perform a method which includes "arranging *images* in a memory of said computer, said *images* corresponding to *images* encoded on said storage media", as recited in amended independent claim 33.

None of the aforementioned references includes any mention of arranging "images" as in the computer readable media of claim 33. Although '031 includes some mention of "label data" being recorded on the compact disc, this data is not disclosed as being an "image". None of the other references include any mention or suggestion of printing or arranging "images". Thus, when taken in combination, these references do not disclose or suggest the limitations of amended independent claim 33.

Accordingly, the Applicants respectfully traverse this rejection since the combination of the cited references does not produce the invention recited in

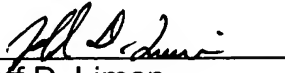


the Applicants' claims. Thus, the Applicants request that the Examiner withdraw all rejections to the claim and pass the application onto allowance.

II. Additional Fees

It is not believed that additional fees are due at this time; however, if any additional fee is required in connection with the filing of this Amendment, please charge the fee to Deposit Account No. 08-2025.

Respectfully Submitted,  
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